

REMARKS

Applicants respectfully request reconsideration of the present U.S. Patent application. No claims have been added or cancelled. Thus, Claims 1-16 are pending.

REJECTIONS UNDER 35 U.S.C. § 103(a)

Claims 1-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,309,563 issued to Farrand, et al. (*Farrand*) in view of U.S. Patent No. 6,065,053 issued to Nouri, et al. (*Nouri*). For at least the reasons set forth below, Applicants submit that claims 1-16 are not rendered obvious by *Farrand* in view of *Nouri*.

The Manual of Patent Examining Procedure (“MPEP”), in § 706.02(j), states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the **prior art reference** (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be both found in the prior art and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(Emphasis added). Thus, the MPEP and applicable case law require that the Office action establish that a combination of references teach or suggest **all of the claim limitations** of rejected claims to sustain an obviousness rejection under 35 U.S.C. § 103. As shown below, Applicants respectfully submit that the Office action does not establish a *prima facie* case of obviousness.

Independent claim 1 recites:

In a **client device**, a method comprising:
receiving externally provided control operations;
determining a current operating state of said client device; and

conditionally executing said control operations if execution of said control operations are permitted while said client device is in said determined current operating state.

(Emphasis added).

Regarding the claim limitation directed to, “**conditionally executing said control operations if execution of said control operations are permitted while said client device is in said determined current operating state,**” the Office action directs the Applicants’ attention to column 6, lines 2-12 of *Nouri*, wherein *Nouri* states:

a self-contained network of microcontrollers, such as, for example, a remote interface board or a circuit 104, a system interface microcontroller 106 and system recorder microcontroller 110. This distributed service processor network 102 may operate as a fully self-contained subsystem within the server system 100, continuously monitoring and managing the physical environment of the machine (e.g., temperature, voltages, fan status). The microcontroller network 102 continues to operate and provides a system administrator with critical system information, **regardless of the operational status of the server.**

(Emphasis added). Thus, the cited passage of *Nouri* merely discloses “a distributed service processor network.” The **conditional execution** of control operations is not mentioned. Specifically, “**conditionally executing ... control operations if execution of said control operations are permitted while said client device is in said determined current operating state,**” is not disclosed. On the contrary, since the cited passage states that, “microcontroller network 102 continues to operate ... **regardless of the operational status of the server,**” it explicitly teaches away from “**conditionally executing ... control operations if execution of said control operations are permitted while said client device is in said determined current operating state,**” as claimed by Applicants.

To establish *prima facie* obviousness the Office action must show that there is some motivation, suggestion or teaching of the desirability of modifying the reference in the manner proposed by the Office action. *See In re Kotzab*, 55 USPQ2d 1313 (Fed. Cir. 2000).

The motivation, suggestion, or teaching to modify the reference must be **supported by particular findings of fact**. Broad conclusory statements standing alone are not sufficient to establish *prima facie* obviousness. The Office action states that, “it would have obvious” to combine the cited passage of *Farrand* with the cited passage of *Nouri*, without making any findings of fact supporting the conclusion. For at least the reason that the Office action does not support the quoted statement with particular findings of fact, Applicants respectfully submit that a *prima facie* case of obviousness has not been established.

In summary, Applicants respectfully submit that the Office action does not establish a *prima facie* case of obviousness based on *Farrand* in view of *Nouri*. In particular, Applicants respectfully submit that the cited references, alone or in combination, do not teach or suggest, “**conditionally executing ... control operations if execution of said control operations are permitted while said client device is in said determined current operating state**,” as recited in claim 1. Also, Applicants respectfully submit that the Office action fails to show that there is some motivation, suggestion or teaching of the desirability of combining the references in the manner proposed by the Office action based on particular findings of fact. Therefore, Applicants respectfully submit that *Farrand* in view of *Nouri* does not render claim 1 obvious. Claims 2-7 depend from 1. For at least the reason that dependent claims include the limitations of the claims from which they depend, Applicants submit that claims 2-7 are not rendered obvious by *Farrand* in view of *Nouri*.

Independent claim 8 recites:

- a first electronic component;
- a bus;
- a sensor coupled to said bus and said first electronic component; and

a second electronic component coupled to said bus to conditionally cause said first electronic component to perform a plurality of functions through said sensor, via said bus, responsive to externally provided control operations.

Regarding the claim limitations directed to, “a first electronic component … a bus … [and] a sensor coupled to said bus and said first electronic component,” the Office action directs the Applicants’ attention to column 22, lines 32-65 of *Nouri*, wherein *Nouri* states:

An exemplary message from the microcontroller network table includes “temperature sensor #5 exceeds warning threshold.”...

Referring to FIG. 11, the Read NVRAM Contents function 710 will now be described. ... The System Recorder memory or NVRAM 112 (FIG.2) has two 64K byte memory blocks. The first block is a memory block which stores ID codes of the devices installed in the network ... The second block of the memory 112 is a memory block that stores event messages in a connection with events occurring in the network.

... Proceeding to state 746, function 710 returns the log message to the requestor on the microcontroller bus.

Applicants note that the passage cited by the Office action includes three different paragraphs that are not closely related to each other. Moreover the three cited paragraphs are generally directed to processes rather than an apparatus. The only use of the word sensor, in the cited passage occurs in the exemplary message shown above. Similarly, the only use of the word bus in the cited passage is in the third paragraph, which is directed to a software function. Assuming for the sake of argument that the first paragraph discloses a sensor (rather than merely disclosing an exemplary message), there is no indication that a sensor associated with the message is coupled to the bus as recited in claim 8. Moreover, the cited passage does not teach or suggest “a first electronic component” that is coupled to the sensor mentioned in the first paragraph **and** the bus mentioned in the third paragraph. Therefore Applicants respectfully submit that the cited passage does not teach or suggest, “a first electronic

component ... a bus ... [and] a sensor coupled to said bus and said first electronic component," as recited in claim 8.

In summary, Applicants respectfully submit that the Office action does not establish a *prima facie* case of obviousness against claim 8 based on the cited passages of *Nouri*.³¹ In particular, the cited passages of *Nouri* fail to teach or suggest "a first electronic component ... a bus ... [and] a sensor coupled to said bus and said first electronic component," as claimed by Applicants. Therefore, Applicants respectfully submit that claim 8 is not rendered obvious by *Nouri*. Claims 9-16 depend from 8. For at least the reason that dependent claims include the limitations of the claims from which they depend, Applicants submit that claims 9-16 are not rendered obvious by *Nouri*.

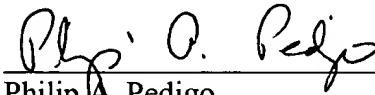
CONCLUSION

For at least the foregoing reasons, Applicants submit that the rejections have been overcome. Therefore, claims 1-16 are in condition for allowance and such action is earnestly solicited. Applicants have attached an appendix showing claims 1-16 for the convenience of the Examiner. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application.

Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP

Date: February 10, 2003


Philip A. Pedigo
Attorney for Applicant
Reg. No. 52,107

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025-1026
(503) 684-6200